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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/726,392	12/01/2000	Yoshimasa Fujita	900-360	1283

23117 7590 07/29/2003

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EXAMINER

NILAND, PATRICK DENNIS

ART UNIT	PAPER NUMBER
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1714

DATE MAILED: 07/29/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/726,392

Applicant(s)

FUJITA, YOSHIMASA

Examiner

Patrick D. Niland

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 May 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 and 14-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 and 14-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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1. The amendment of 11/12/02 has been entered. Claims 1-11 and 14-16 are pending.
2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-7, 9-11, and 14-20 are rejected under 35 U.S.C. 102(b) as being anticipated by US Pat. No. 5958609 Ueda et al..

Ueda et al. discloses the instantly claimed composition at column 14, lines 20-47 and the remainder of the document. Lower polymer molecular weights and higher solvent amounts will necessarily inherently give the instantly claimed viscosities by definition of intrinsic viscosity and inherent viscosity. The argument regarding the ink jet technique is not persuasive as these claims are drawn to the composition, not its method of use. There is no probative evidence that these compositions could not be used as ink jet inks. The claims recite "solvent" which encompasses toluene. Furthermore, page 9 of the instant specification contradicts the applicant's

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representative's argument with regard to toluene's usefulness as an inkjet solvent. The argument re claim 14 ignores the fact that the claim is directed to a composition, not its method of use. The applicant's argument is directed towards the intended use of the instantly claimed composition. The instant claims are directed towards a composition, not its intended use. The composition is defined solely by its ingredients and the amounts thereof. The instant recitation of the intended use of the composition does nothing to further define the composition to one of ordinary skill in the art. The US Patent and Trademark Office cannot patent claims directed towards a composition which is not novel or is obvious only because the inventor has found a novel use for the composition. See *In re Pearson*, 494 F. 2d 1399, 181 USPQ 641 (CCPA 1974). It is not seen that the patentee does not inherently encompass the parameters of newly added claims 17-20 since the compositions otherwise fall within the scope of these claims. For these reasons, this rejection is maintained.

5. Claims 1-11 and 14-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat. No. 5958609 Ueda et al..

Ueda et al. discloses the instantly claimed composition at column 14, lines 20-47 and the remainder of the document. Lower polymer molecular weights and higher solvent amounts will necessarily inherently give the instantly claimed viscosities by definition of intrinsic viscosity and inherent viscosity. It would have been obvious to one of ordinary skill in the art at the time of the instant invention to use the instantly claimed mixture of ingredients to give the instantly claimed viscosities because they are encompassed by the patentee's disclosure and would have

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been expected to give predictable film properties to the ordinary skilled artisan. It would have been obvious to one of ordinary skill in the art at the time of the instant invention to use the solvents of the instant claim 8 in the composition of the patentee because they are of similar hydrophile/lipophile balance and vapor pressures as those of the patentee and therefore would have been expected to function similarly as the solvents of the patentee and they are encompassed by the patentee's recitation of "and the like". The argument regarding the ink jet technique is not persuasive as these claims are drawn to the composition, not its method of use. There is no probative evidence that these compositions could not be used as ink jet inks. The claims recite "solvent" which encompasses toluene. Furthermore, page 9 of the instant specification contradicts the applicant's representative's argument with regard to toluene's usefulness as an inkjet solvent. The argument re claim 14 ignores the fact that the claim is directed to a composition, not its method of use. The applicant's argument is directed towards the intended use of the instantly claimed composition. The instant claims are directed towards a composition, not its intended use. The composition is defined solely by its ingredients and the amounts thereof. The instant recitation of the intended use of the composition does nothing to further define the composition to one of ordinary skill in the art. The US Patent and Trademark Office cannot patent claims directed towards a composition which is not novel or is obvious only because the inventor has found a novel use for the composition. See *In re Pearson*, 494 F. 2d 1399, 181 USPQ 641 (CCPA 1974). It is not seen that the patentee does not inherently

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encompass the parameters of newly added claims 17-20 since the compositions otherwise fall within the scope of these claims. For these reasons, this rejection is maintained.

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick Niland whose telephone number is (703) 308-3510. The examiner can normally be reached on Monday to Friday from 9:30 to 6:00.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan, can be reached on (703) 306-2777. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-5408.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

pn

July 27, 2003



Patrick Niland
Primary Examiner
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